

REMARKS

Upon entry of this paper, claims 1 and 3 have been amended, no claims have been canceled, and no claims have been added as new claims. Thus, claims 1-5 are presently pending in this application. No new matter has been added.

Applicant thanks the Examiner for the indication that the 35 USC §112 rejections have been withdrawn in view of remarks provided by the Applicant.

Claim 1 has been amended to indicate that the support dome of the present invention includes a filter bypass valve. As can be seen in figures 1a-1c, 2 and 3, and as supported in the specification at page 3, lines 19-22, the support dome “. . . holds a valve body 7 of a filter bypass valve 8. When the pressure outside filter insert 4 is high, valve body 7 is pressed downward, thereby opening a flow passage between valve body 7 and its associated valve seat which is formed by a collar 9 which is in turn formed by an upper end plate 10 of filter insert 4.” In addition, as can be seen in figures 4a and 4b, and as supported in the specification at page 5, lines 23-25, the “. . . tubular sleeve 18 also forms, in this embodiment, the movable valve body of the filter bypass valve which is provided, in this embodiment, below filter insert 4.”

Accordingly no new matter has been added with this amendment with the addition of the filter bypass valve configured within the filter.

Claim Rejections Under 35 USC § 102

Claims 1, 2 and 5 are rejected under 35 U.S.C. 102(b) as being anticipated by EP 0 492 627-A2, hereinafter ‘627. Claim 1 has been amended to more clearly identify the claimed invention. Applicant further distinguishes the claimed invention from the ‘627 reference according to the following remarks.

Claim 1 includes “a filter bypass valve disposed within the filter for enabling bypass of the filter;” See amended claim 1. The ‘627 reference does not disclose, nor does it teach or

suggest, existence of a bypass valve configured for bypassing the filter. As such, Applicant respectfully submits that claim 1 is allowable over the '627 reference.

Claims 2 and 5 depend from claim 1, and therefore include the limitations of claim 1. As such, claims 2 and 5 are allowable over the '627 reference based on the allowability of claim 1 over the reference, in addition to their own claimed characteristics.

In light of the above comments, applicants respectfully submit that the claims of the present invention are not anticipated by, and are therefore in condition for allowance over, the cited reference.

Claim Rejections Under 35 USC § 103

Claims 3 and 4 are rejected under 35 U.S.C. 103(a) as being unpatentable over '627 in view of GB 2,279,725, hereinafter '725. Applicant respectfully traverses this rejection in view of the following remarks.

Claims 3 and 4 depend from claim 1. As such, the combination of the '627 reference with the '725 reference must either teach or suggest all elements of claim 1 in combination with claims 3 and 4 respectively in order for this rejection to be maintained. Applicant respectfully submits that the references cannot be combined in a manner that discloses all claimed elements.

Specifically, there is no disclosure, teaching, or suggestion of "a filter bypass valve" in the '627 reference. In fact, the '627 reference teaches away from such an element when it states that "it is necessary to provide a structure which can prevent the liquid outside the filters from coming inside through a bypass on both end faces." See col. 6, lines 53-56. As such, the '627 reference is not combinable with the '725 reference in terms of the addition of a bypass valve. Absent such combination, there is no disclosure, teaching, or suggestion of a filter bypass valve in the cited references.

Furthermore, if the device of the '627 reference were modified to add a bypass valve, the device of the '627 patent would not operate as intended. The reference specifically refers to the

undesirable effects of a bypass path as noted above. Inclusion of a filter bypass valve in the device of the '627 would be inapposite with the invention of the '627 reference.

Applicant therefore respectfully submits that the combination of the '627 reference with the '725 to the extent allowable by the respective references fails to disclose or suggest every limitation of Applicant's claims. Applicants further submit that the claims of the present invention are not obvious with respect to, and are therefore allowable over, the cited references.

CONCLUSION

In view of the foregoing, it is respectfully submitted that this application is now in condition for allowance. Applicant courteously solicits allowance of the claims in the form of a Notice of Allowance. Should there be any further outstanding issues of patentability following the entry of this amendment, a telephone interview is respectfully requested to resolve such issues.

Please charge any shortage or credit any overpayment of fees to our Deposit Account No. 12-0080. In the event that a petition for an extension of time is required to be submitted herewith, and the requisite petition does not accompany this response, the undersigned hereby petitions under 37 C.F.R. §1.136(a) for an extension of time for as many months as are required to render this submission timely.

Applicant believes no fee is due with this statement. However, if a fee is due, please charge our Deposit Account No. 12-0080, under Order No. HHI-041US from which the undersigned is authorized to draw.

Dated: August 30, 2005

Respectfully submitted,

By 
Sean D. Detweiler

Registration No.: 42,482
LAHIVE & COCKFIELD, LLP
28 State Street
Boston, Massachusetts 02109
(617) 227-7400
(617) 742-4214 (Fax)
Attorney/Agent For Applicant